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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,053	11/14/2003	Karl E. Benson	59068US002	3183

32692 7590 09/27/2006

3M INNOVATIVE PROPERTIES COMPANY
PO BOX 33427
ST. PAUL, MN 55133-3427

EXAMINER

POWERS, FIONA

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 09/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/714,053

Applicant(s)

BENSON ET AL.

Examiner

Fiona T. Powers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 9-36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 4-6 is/are rejected.
- 7) ☒ Claim(s) 3, 7 and 8 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>3/4/04, 4/13/05, 1/23/06</u> | 6) <input type="checkbox"/> Other: _____ |

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Receipt is acknowledged of the information disclosure statements filed March 4, 2004, April 13, 2005 and January 23, 2006, which have been entered in the file.

Applicant's election with traverse of Group I, Claims 1 to 8 in the reply filed on June 30, 2006 is acknowledged. The traversal is on the ground(s) that Groups I, III and V are so interrelated that a search of one group of claims will reveal art to the other groups and Groups II, IV and VI are so interrelated that a search of one group of claims will reveal art to the other groups. This is not found persuasive because the groups are separately classified so a search of one group will not necessarily reveal art to the other groups.

The requirement is still deemed proper and is therefore made FINAL.

Claims 9 to 36 stand withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on June 30, 2006.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 4, 5 and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Clader et al. (US 5238950), cited by applicants or Bozhinov et al. (Chemical Abstracts, 117:235734, 1992), cited.

The references disclose the claimed compounds of the formula I wherein R^1 and R^2 together with the dicarboximide group form a 5-membered ring that is fused to an aromatic group; Y^1 is arylene, alkylene, NH, carbonyl, oxy or combinations thereof; X^1 is carboxy, haloalkyl, primary aromatic amino, secondary aromatic amino, cyano, hydroxy or ethylenically unsaturated group; and r is 1 and for claim 5, Ar^1 is phenylene and Y^{1a} is a single bond, alkylene, oxy, NH or carbonyl or combinations thereof. Note Registry No. 144482-86-0 of Bozhinov et al. and Examples 1B, 1E, 1G, 1R, 1U, 1W, 1BB, 1CC, 1DD, 1II, 2D, 2E and 2F of Clader et al.

Claim 2 is rejected under 35 U.S.C. 102(b) as being anticipated by Clader et al. (US 5238950).

The reference discloses the claimed compounds of the first formula shown in claim 2 wherein R^1 and R^2 together with the dicarboximide group form a 5-membered ring that is fused to an

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aromatic group; Ar¹ is phenylene; L is oxygen; n is 1; and X¹ is carboxy, cyano or ethylenically unsaturated group. Note Examples 1R, 1BB and 1DD.

Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Kharasch et al. (Chemical Abstracts, 47:1656c-i, 1953) or Webb et al. (Chemical Abstracts, 83:189238, 1975) or Yamahara et al. (Chemical Abstracts, 133:357243, 2000) or Kato et al. (Chemical Abstracts, 120:65816, 1994), cited.

Kharasch et al., Webb et al. and Yamarahara et al. disclose the claimed compounds of the formula I wherein R¹ and R² together with the dicarboximide group form a 5-membered ring that is fused to an aromatic group or a bicyclic group; Y¹ is a direct bond or an alkylene group; X¹ is haloalkyl; and r is 1. Note Registry Nos. 6461-72-9, 856829-97-5 and 856830-13-2 of Kharasch et al.; Registry No. 57105-60-9 of Webb et al.; and Registry No. 204315-69-5 of Yamahara et al.

Kato et al. disclose the claimed compound of the formula I wherein R¹ and R² together with the dicarboximide group form a 6-membered ring; Y¹ is a combination of alkylene, oxy and carbonyl; X¹ is an ethylenically unsaturated group; and r is 1. Note Registry No. 151996-59-7.

Claims 3, 7 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in

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independent form including all of the limitations of the base claim and any intervening claims.

The references made of record and not relied upon show the state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fiona T. Powers whose telephone number is 571-272-0702. The examiner can normally be reached on Monday - Friday 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fiona T. Powers
Fiona T. Powers
Primary Examiner
Art Unit 1626

ftp
September 17, 2006